

REMARKS

The Office Action of September 15, 2004 has been reviewed and the Examiner's comments carefully considered. The present Amendment amends claims 21, 23-24 and 30-39 in accordance with the originally filed specification. Claims 20-39 remain in this application.

The specification has been objected to because the word "silice" is used throughout the specification and it is an unknown word to the Examiner. The word "silice" has been replaced with the word "silica" throughout the specification. Further, at the request of the Examiner, the specification has been amended to include the limitations of claims 21-24 with the presently filed Amendment.

Claims 23-24, 36 and 39 have been objected to for informalities. The objected claims have been amended in accordance with the Examiner's suggestions.

Claims 21, 23-24 and 30-39 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. With respect to the §112 rejections, Applicant submits that the above amendments to these claims obviate these rejections. Therefore, the Examiner's rejections have been addressed and overcome by the foregoing Amendment, and Applicant respectfully requests withdrawal of the same.

The Examiner has rejected claims 20-21 and 25-31 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent Application Publication No. US 2004/0166246 to Holcomb (hereinafter "the Holcomb publication"). Further, claims 22-24 and 32-33 stand rejected under 35 U.S.C. §103(a) as being obvious in view of the Holcomb publication. Claims 34, 36 and 39 stand rejected under 35 U.S.C. §103(a) as being obvious over Holcomb as applied to claim 20, and further in view of Shiozawa (U.S. Patent No. 5,478,598). Finally, claims 34-35 and 37-38 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Holcomb as applied to claim 20, and further in view of Crews, IV et al. (U.S. Patent No. 5,205,874).

In view of the attached Declaration, as discussed in detail hereinafter, and the following remarks, Applicant respectfully requests reconsideration of these claim rejections.

The Holcomb publication has been used as the primary reference in all the rejections by the Examiner. It is noted that the Holcomb publication was filed as a PCT Application on March 29, 2002. This application further improperly claims priority to a U.S.

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Provisional Application filed on March 30, 2001. The U.S. Provisional Application is not properly identified on the face of the Holcomb publication. Applicant submits that the earliest filing date obtainable for the invention disclosed in the Holcomb publication is March 29, 2002. However, it could be argued that the earliest filing date for the Holcomb publication goes back to the provisional filing date of March 30, 2001.

Attached hereto and incorporated herein by reference is a *Declaration Under 37 C.F.R. §1.131 Showing Conception and Diligence Prior To March 30, 2001 Until November 29, 2002*, executed by Mr. Julio Burkhard Seeger Stein (hereinafter "the *Stein Declaration*"). Mr. Stein is the named inventor of the invention described and claimed in the present application. *Stein Declaration* ¶ 1. The assignees for the present application are Universidad de Concepcion, Julio Burkhard Seeger Stein, Aserraderos Quelen Quelen S.A., Maderas Impregnadas Preserva Limitada, Barraca y Fabrica de Muebles, and Puertas y Ventanas Silvia Ugarte. *Stein Declaration* ¶ 2. This application was filed in the United States Patent and Trademark Office on November 18, 2003, claiming priority to Chilean Patent Application No. 2746-2002, filed on November 29, 2002. *Stein Declaration* ¶¶ 11 and 12.

Mr. Stein worked from 1995 to obtain the development of the impregnation of wood with boron in an aqueous solution. *Stein Declaration* ¶ 3. His initial work was carried out until February of 1996. *Stein Declaration* ¶ 4.

After his initial investigation Mr. Stein observed wood that was fossilized with high contents of silica which prompted him to devise methods to petrify wood with silica and boron or with silica alone in a fastidious manner. He also studied the treatment of wood with soluble salts of aluminum that form an insoluble hydroxide inside the wood, and also the combination of these components with diverse metallic salts in the wood, for example, of alkaline-earth metals, such as zinc and copper. *Stein Declaration* ¶ 5.

These further studies were carried out on a laboratory scale up until 1999, with promising results being obtained, such as a drastic decrease of the flammability of wood and a decrease in the insect attack on the wood. The favorable results were obtained with the treatment containing both silicates and borates, however, Mr. Stein observed that silicates alone showed favorable results. *Stein Declaration* ¶ 6.

Mr. Stein obtained financing for two years to continue his studies on a larger scale. *Stein Declaration* ¶ 7. In order to qualify for the funding of his larger project, Mr. Stein had to present his research proposal to the National Commission of Scientific and Technological Research in 1999. *Stein Declaration* ¶ 8. A copy of excerpts from this presentation to receive funding money is attached as Exhibit A, along with an English-language translation thereof. In the summary and in the general formulation of the proposal therein, it is expressed with clarity that in 1999 Mr. Stein had carried out experiments that demonstrate the technology of wood impregnation with silica and boron. *Stein Declaration* ¶ 9. Mr. Stein continued to apply his method to wood throughout the next two years in the experimental phases. *Stein Declaration* ¶ 10.

The present application was filed in the United States Patent and Trademark Office on November 18, 2003, claiming priority to the aforementioned Chilean Patent Application No. 2746-2002, filed on November 29, 2002. *Stein Declaration* ¶ 12.

Mr. Stein declares that his invention was not sold or in public use in the United States for one year prior to the date of the present application, nor was it patented or described in a publicly accessible publication anywhere prior to that time. In addition, the invention was never abandoned. *Stein Declaration* ¶ 13.

Therefore, this activity prior to the purported March 30, 2001 priority date of the application underlying the Holcomb publication until November 29, 2002, which is the effective filing date of the priority Chilean Patent Application No. 2746-2002, demonstrates the required evidence of conception and diligence. *Stein Declaration* ¶ 14.

Accordingly, the invention underlying the present application was conceived prior to the purported priority date of the Holcomb publication (March 30, 2001), and it is also prior to the PCT filing date of the Holcomb publication (March 29, 2002), and the present invention was diligently reduced to practice through the November 29, 2002 filing date of the Chilean Patent Application No. 2746-2002. Therefore, the Holcomb publication does not represent prior art and should be withdrawn from consideration. In the present application, claim 20 is in independent form. With the withdrawal of the Holcomb publication as a prior art reference to the present invention, independent claim 20 and the subsequent dependent claims 21-39, are not anticipated by or rendered obvious over the Holcomb publication, the Shiozawa patent, the Crews, IV et al. patent, or any of the other

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prior art of record, whether used alone or in combination. There is no hint or suggestion in any of the references cited by the Examiner to combine these references in a manner which would render the invention, as claimed, obvious. Reconsideration of the rejection of independent claim 20 and dependent claims 21-39, which depend either directly or indirectly from and add further limitations to independent claim 20 is respectfully requested.

Therefore, for all the foregoing reasons, Applicant believes that claims 20-39, as amended, are patentable over the cited prior art and in condition for allowance. Reconsideration of the rejections and allowance of all pending claims 20-39 are respectfully requested.

Respectfully submitted,

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